



01-27-05

AF/IMW

Atty. Dkt. No. 035451-0185 (3731.Palm)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Fraser et al.

Title: INTERCHANGEABLE DISPLAY
MODULES FOR PORTABLE
HANDHELD DEVICES

Appl. No.: 10/085,310

Filing Date: 02/28/2002

Examiner: Abbas I. Abdulsalam

Art Unit: 2674

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Mail Stop APPEAL BRIEF - PATENTS
Commissioner for Patents
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Sir:

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Final Office Action dated June 1, 2004, and in the Advisory Action dated November 2, 2004, finally rejecting Claims 1-6, 7-15 and 17-29.

[X] Brief on Appeal (16 pages).

The required fees are calculated below:

[X]	Filing a Brief in Support of an Appeal Fee:	\$500.00
[]	Extension month:	\$0.00
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	FEE TOTAL:	\$500.00
[]	Small Entity Fees Apply (subtract ½ of above):	\$0.00
	TOTAL FEE:	\$500.00

- [X] A check in the amount of \$500.00 is enclosed.
- [X] The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447.

Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

Respectfully submitted,

Date January 26, 2005

By Alistair K. Chan

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 297-5730
Facsimile: (414) 297-4900

Alistair K. Chan
Attorney for Applicant
Registration No. 44,603



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Fraser et al.

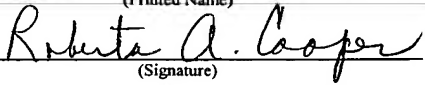
Title: INTERCHANGEABLE DISPLAY
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APPEAL BRIEF

Mail Stop Appeal Brief - Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Under the provisions of 37 C.F.R. § 41.37, this Appeal Brief is being filed together with a check in the amount of \$500.00 covering the 37 C.F.R. § 41.20(b)(2) appeal fee. If this fee is deemed to be insufficient, authorization is hereby given to charge any deficiency (or credit any balance) to the undersigned deposit account 06-1447.

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1. REAL PARTY IN INTEREST

The real party in interest is palmOne, Inc. of Milpitas, CA. palmOne, Inc. holds title to the present Application.

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences that will directly affect, be directly affected by, or have a bearing on the present appeal, that are known to Appellant or Appellant's patent representative.

3. STATUS OF CLAIMS

The present appeal is directed to Claims 1-15 and 17-29, all of which stand rejected pursuant to a final Office Action dated June 1, 2004.

4. STATUS OF AMENDMENTS

Claims 1-29 were pending in the application when a final Office Action dated June 1, 2004 was issued. Claim 16 has been cancelled.

No amendments to the claims have been made subsequent to the final Office Action dated June 1, 2004.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention relates generally to a handheld computing device (100) that can communicate with a plurality of visual displays (150) based upon a user's current needs. The present invention also relates generally to handheld computing devices (100) having detachable displays (150) whereby a user can upgrade either a processing unit or a display unit. Further still, the present invention relates generally to a method (300) for a handheld computing device (100) that can be used to recognize and communicate with a plurality of detachable visual display units (150). See also, Specification, ¶ [0008].

In one embodiment, an identifier indicia is passed by a communication interface (155) on the display (130) to a processing unit (110) via a communication interface (130) coupled

to the processing unit to indicate to the processing unit (110) the properties of the detachable visual display unit (150).

Independent Claim 1 relates to a handheld computing device (100). (See also, Specification, ¶ [0021]). The handheld computer comprises a processing unit (110) (See, Specification ¶¶ [0022]-[0023]) having a communication interface (130). The processing unit (110) includes a first communication interface (130) for communication with a visual display unit (150). The handheld computing device (100) also comprises a detachable visual display unit (150) (See, Specification ¶ [0027]). The detachable visual display unit (150) is communicatively coupled to the first communication interface (130) by a second communication interface (155) (See, Specification ¶¶ [0027]-[0028]). An identifier indicia is passed by the second communication interface (155) to the processing unit (110) via the first communication interface (130) to indicate to the processing unit (110) the properties of the detachable visual display unit (150) (See also, Specification ¶¶ [0029]-[0030]).

Independent Claim 15 relates to a handheld computing device (110) facilitating a detachable visual display unit (150). The device comprises a processing unit (110) having a power source (120). The handheld computing device also comprises a communication port (130) for communicating with a detachable visual display unit (150). The communication port (130) is capable of receiving information representative of properties of the detachable visual display unit (150) (See also, Specification ¶ [0025]-[0030]).

Independent Claim 22 relates to a visual display unit (150) for a handheld computing device (100). The visual display unit (150) comprises a housing detachable from the handheld computing device (110) (See, e.g., Fig. 1A). The visual display unit (150) also comprises a display screen (See, e.g., Fig. 1A and Fig. 2). Further, the visual display unit comprises a communication interface (155) including an identifier indicia to indicate to a handheld computing device (110) the properties of the visual display unit (150) (See Specification ¶¶ [0025]-[0030]).

Independent Claim 26 relates to a method (300) of displaying data from a handheld computing device (110). The method comprises detecting (320) the properties of the detachable visual display unit (150) communicatively coupled to the handheld computing device (110). The method also comprises updating display drivers (330) on the detachable

visual display unit (150) properties detected. Further, the method comprises transmitting data (340) from the handheld computing device (110) to the communicatively coupled detachable visual display unit (150).

6. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The issues on appeal are (1) whether the Examiner erred in rejecting Claims 1-29 as being unpatentable over U.S. Patent No. 5,579,487 (Meyerson et al.) under 35 U.S.C. § 103(a) over knowledge generally available to one of ordinary skill in the art.

7. ARGUMENT

A. LEGAL STANDARDS

Claims 1-29 have been rejected under 35 U.S.C. § 103(a), which states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The legal standards under 35 U.S.C. § 103(a) are well-settled. Obviousness under 35 U.S.C. § 103(a) involves four factual inquiries: 1) the scope and content of the prior art; 2) the differences between the claims and the prior art; 3) the level of ordinary skill in the pertinent art; and 4) secondary considerations, if any, of nonobviousness. See Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966).

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. In re Piasecki, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). “[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

As noted by the Federal Circuit, the “factual inquiry whether to combine references must be thorough and searching.” McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 60 USPQ.2d 1001 (Fed. Cir. 2001). Further, it “must be based on objective evidence of record.” In re Lee, 277 F.3d 1338, 61 USPQ.2d 1430 (Fed. Cir. 2002). The teaching or suggestion to make the claimed combination must be found in the prior art, and not in the applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990). “It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to ‘[use] that which the inventor taught against its teacher.’” Lee (citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)).

B. REJECTION OF CLAIMS 1-15 AND 16-29 UNDER 35 U.S.C. § 103(a) OVER MEYERSON ET AL.

In the final Office Action dated June 1, 2004, Claims 1-29 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,579,487 to Meyerson et al.

I. The Examiner’s rejection of Claims 1-29 under 35 U.S.C. § 103(a) over Meyerson et al. should be reversed because there is no suggestion to combine the teachings of Meyerson et al. with knowledge of one of ordinary skill in the art.

To establish a prima facie case of obviousness based on a combination of prior art references under 35 U.S.C. § 103(a), the Examiner must first show that there is a suggestion or motivation to combine the teachings of those references. This may come in the form of some objective teaching in the prior art or, alternatively, knowledge generally available to one of ordinary skill in the art at the time of the invention that would lead that individual to combine the relevant teachings of the references. When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. Ex parte Skinner, 2 USPQ.2d 1788 (Bd. Pat. App. & Inter. 1986).

In this case, the Examiner has not shown – and indeed, cannot show – that there would have been any motivation or suggestion to one of skill in the art to combine general knowledge with the teachings of Meyerson et al.

A brief description of the teachings of the cited references may be helpful for the following discussion. Meyerson et al. relates generally to a configurable work slate unit that is customizable for a user by dismantling the unit and selectively integrating the desired parts into the unit.

Nevertheless, during prosecution of the present application, the Examiner has alleged a variety of reasons why one of ordinary skill in the art would have been motivated to combine their knowledge with the teachings of Meyerson et al. none of which appear to provide a proper motivation that may be relied upon in combining these references.

It is unclear where the Examiner found the asserted motivation, which cannot be located by the Appellant (or, presumably, by those of ordinary skill in the art) in the teachings of Meyerson et al.

As noted in M.P.E.P. § 2143.01 (with emphasis added):

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.”

Appellants’ remark that the Meyerson et al. patent is not applicable in that it discloses a work slate computer, whereas what Appellants have claimed is a “handheld computing device” in independent claims 1, 15, 22 and 26. The recitation of a “handheld computing device” or “handheld computer” should be construed more narrowly than including a work slate computer as construed by the Examiner. Terms of the claims should be given their plain meaning. Here, Appellants are concerned with the construction of the words “handheld

computer” by the Examiner. The Examiner has construed the work slate computer which is disclosed in Meyerson et al. as a handheld computer. Applicants, however, disagree.

Appellants submitted with a reply dated March 15, 2004 an Exhibit A which indicates that a “handheld computer” is “a computer small enough to be carried in your pocket.” A work slate computer as disclosed in Meyerson et al., is not one which can conventionally be carried in your pocket. Appellants also submitted an Exhibit, an alternative definition of the term “handheld” as it refers to computers. The Exhibit from the website SearchMobileComputing.com describes a handheld computer as “a computer that can conveniently be stored in a pocket (of sufficient size) and used while you are holding it.” Thus, it is clear that the plain meaning of “handheld computer” should not be construed to include work slate computers, as the Examiner has suggested. Further still, it should be appreciated that the Appellant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the terms’ well known usage. In re Hill, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Accordingly, Appellants refer the Examiner to the specification which states at paragraph [0003] “the size of the handheld computing device is generally compact and correspondingly, the visual display is smaller than the size of a standard computer monitor. The small size of the screen allows handheld computing devices to be portable, but less than ideal for viewing complex images of documents. The small size of the screen has necessitated that handheld computing devices focus on displaying abbreviated or simplistic content.”

In contrast, the work slate computer of Meyerson et al. has a display which is relatively large and could easily be used for viewing complex images of documents, e.g. Further, Appellants refer the Examiner to paragraph [0022] which states that a handheld computer can be “a handheld personal digital assistant (PDA), a wireless mobile phone, a pager, or any such device.” As is well known, all of these devices are approximately the size which could be conveniently carried in your pocket. Thus, it is clear that the Appellants have defined the term “handheld computer” within specified constraints which would not include the work slate computer of Meyerson et al. Work slate computers, such as those disclosed in Meyerson et al. conventionally do not fit in a pocket. Thus, for these reasons, the Meyerson et al. patent is not applicable.

The Examiner indicated that just because Meyerson et al. (U.S. Patent No. 5,579,487) describes a configurable electronic work slate unit as being selectively integrated in a compact and highly ergonomic structure, an example of which includes an RF communication model, that there is some analogy of a work slate unit to the handheld computing device of Appellants' claims. Further, the Examiner indicates that a scenario where size and shape is of no importance in two cited CCPA cases indicates that a work slate unit taught in Meyerson et al. is the same as a handheld computing device of Appellants' claims. To these two assertions, Appellants disagree.

As explained in Appellants' reply of March 15, 2004, Appellants provided ample evidence of the definition of a "handheld computer" thereby differentiating it from a work slate computer. Further, Appellants respectfully submit that just because the work slate computer of Meyerson et al. includes a RF modulator for radio frequency communication, does not mean that it is anything like a handheld computer. RF modulators for radio frequency communication may be incorporated into devices of any size. Further, the Examiner indicates that what is described in Meyerson et al. is an electronic work slate unit in a compact and highly ergonomic structure. However, Appellants respectfully submit that compact and highly ergonomic structure in 1992, when the original Meyerson et al. application was filed, had different meaning to one of ordinary skill in the art than it did at the time of Appellants' filings in 2002. Further, just because Meyerson et al. describes a compact and highly ergonomic structure, it does not describe a handheld computing device. The work slate unit which is the only device taught by Meyerson et al. would have been seen as a compact and ergonomic structure, especially at the time in which the application was filed in 1992. Accordingly, there is no teaching or suggestion of a handheld computing device in Meyerson et al.

Further, the Examiner indicated that where size and shape is of no importance, there is no difference between a work slate unit and a handheld computer. However, Applicants refer the Examiner to the Specification in which the advent of the handheld computer makes it important for the Applicants' invention. For example, the Applicants refer the Examiner to page 1 of the application to page 3 of the application, paragraphs [0003] to [0008]. In these

paragraphs, the Applicants provide meaningful reasons for needing the claimed invention, including, but not limited to the fact that handheld computing devices were at the time of the invention, in transition and therefore it would have been beneficial to provide an interchangeable display unit. Further, and possibly more importantly, because the needs of different users of the handheld computing unit may be vastly different due to its extremely small size and extreme portability, there may be a need to interchange displays for a single user or for different users. Therefore, there is a significant reason for Applicants to provide interchangeable display modules for a handheld computing device. As such, Applicants have claimed in Claims 1-15 and 17-29, a handheld computing device and therefore the teachings of Meyerson et al. are not applicable. Based on this alone, Applicants respectfully submit that Claims 1-15 and 17-29 are allowable.

Because the Examiner has not shown that the purported motivation to combine the teachings of Meyerson et al. has come from the reference itself or from knowledge generally available to one of ordinary skill in the art, the Examiner has not provided a proper case of obviousness.

The Examiner's most recent alleged motivation is thus similar to reasoning which was held to be insufficient to support a motivation to combine teachings of cited references by the U.S. Court of Appeals for the Federal Circuit. In re Lee, 277 F.3d 1338, 61 USPQ.2d 1430 (Fed. Cir. 2002). In that case, the Board stated that the "conclusion of obviousness may be made from common knowledge and common sense of a person or ordinary skill in the art without any specific hint or suggestion in a particular reference." The Federal Circuit rejected this logic, stating that "neither the examiner nor the Board adequately supported the selection and combination of the . . . references to render obvious that which Lee described."

Without a proper motivation to combine the teachings of Meyerson et al. and knowledge of one of ordinary skill in the art, it is apparent that hindsight reasoning has been used that relies on the Appellant's own disclosure as a roadmap.

Accordingly, the Appellant respectfully requests reversal of the rejection of Claims 1-15 and 17-29.

II. The Examiner's rejection of Claims 4, 5, and 23 under 35 U.S.C. § 103(a) over Meyerson et al. should be reversed because at least one limitation of each of these claims is not taught or suggested by the reference.

Even if the teachings of one of ordinary skill in the art and Meyerson et al. could be properly combined, Claims 4, 5, and 23 still would not have been obvious to one of ordinary skill in the art at the time of the invention.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art (see M.P.E.P. § 2143.03). Because at least one limitation of each of independent Claims 4, 5, and 23 is not taught or suggested by the combination of one of ordinary skill in the art and Meyerson et al., these claims (and their associated dependent claims) would not have been obvious to one of ordinary skill in the art at the time of the invention.

With regard to Claims 4, 5, and 23, Meyerson et al. does not disclose, teach, or suggest a flexible, expandable, or foldable display. The need for a flexible, expandable, or foldable display is a unique need for a handheld computing device. In fact, the teachings of Meyerson et al. of a work slate computer, provide no advantage for a expandable, flexible, or foldable display, because the work slate computer of Meyerson et al. is already a fairly large size and therefore an expandable or foldable display is not required and a flexible display also provides no advantages, because many expandable or foldable displays are also flexible. Meyerson et al., as the Examiner indicated, teaches a removable sheet display which is described as a planar display in an LCD display configuration. See, for example, column 6, lines 55-67. Nowhere in Meyerson et al. is there taught a flexible display, an expandable display, or a foldable display as is contemplated by Appellants and described in paragraph [0027] on page 7, paragraph [0034] on page 9, and paragraph [0037] on pages 9 and 10. Because Meyerson et al. does not disclose, teach, or suggest a flexible, expandable, or foldable display, Appellants respectfully submit that the rejection of Claims 4, 5, and 23 should be withdrawn.

The rejection of Claims 4, 5 and 23 should be reversed, because at least one element of each of these claims is not taught or suggested by the combination of knowledge of one of ordinary skill in the art and Meyerson et al.

Accordingly, the Appellant respectfully requests reversal of the rejection of Claims 4, 5, and 23.

III. The Examiner's rejection of Claims 2, 20, and 21 under 35 U.S.C. § 103(a) over knowledge of one of ordinary skill in the art in view of Meyerson et al. should be reversed because at least one limitation of each of these claims is not taught or suggested by the combination.

The Examiner has rejected Claims 2, 20, and 21 under 35 U.S.C. § 103(a).

Appellants respectfully submit that Meyerson et al. does not teach the use of wireless connections for the display device. See, e.g., pages 6-7, paragraph [0026]. Appellants contemplate that the display device may be used not only while attached to the handheld computing device, but also while being separated from the handheld computing device. What is taught in Meyerson et al. is that there may be a back assembly 170 which attaches to module docking assembly 172 that has a direct connection, flexible wire connection, optical, radio, capacitive, or other coupling arrangements. What is not contemplated by Meyerson et al. is that there is a wireless connection between the display unit 64A and the docking assembly. See, for example, column 10, lines 4-28. Appellants however, contemplate, as stated above that there may exist a wireless connection between the handheld computing device providing advantages which were not contemplated by Meyerson et al. Accordingly, Appellants respectfully submit that the rejection of Claims 2, 20, and 21 should be withdrawn.

The rejection of Claims 2, 20, and 21 should be reversed, because at least one element of Claims 2, 20, and 21 are not taught or suggested by the combination of knowledge of one of ordinary skill in the art and Meyerson et al. Accordingly, the Appellants respectfully requests reversal of the rejection of Claims 2, 20, and 21.

CONCLUSION

In view of the foregoing, the Appellant submits that Claims 1-15 and 17-29 are not properly rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,579,487 in view of knowledge of one of ordinary skill in the art and are therefore patentable. Accordingly, the Appellant respectfully requests that the Board reverse all claim rejections and indicate that a notice of allowance respecting all pending claims should be issued.

Respectfully submitted,

Date January 26, 2005

By Alistair K. Chan

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 297-5564
Facsimile: (414) 297-4900

Alistair K. Chan
Attorney for Applicant
Registration No. 44,603

CLAIMS APPENDIX

1. A handheld computing device comprising:
a processing unit having a communication interface, the processing unit including a first communication interface for communication with a visual display unit; and
a detachable visual display unit, the detachable visual display unit communicatively coupled to the first communication interface by a second communication interface;
wherein an identifier indicia is passed by the second communication interface to the processing unit via the first communication interface to indicate to the processing unit the properties of the detachable visual display unit.

2. The handheld computing device of claim 1, wherein the first communication interface includes a wireless communication interface.

3. The handheld computing device of claim 1 wherein the detachable visual display unit includes a flat, rigid display.

4. The handheld computing device of claim 1 wherein the detachable visual display unit includes a flexible display.

5. The handheld computing device of claim 1, wherein the detachable visual display unit is expandable.

6. The handheld computing device of claim 1, wherein the detachable visual display unit includes a cathode ray tube display.

7. The handheld computing device of claim 1, wherein the detachable visual display unit includes a LCD screen.

8. The handheld computing device of claim 1, wherein the detachable visual display unit includes an electronic whiteboard.

9. The handheld computing device of claim 1, wherein the detachable visual display unit is ruggedized.

10. The handheld computing device of claim 1, wherein the detachable visual display unit is weather protected.

11. The handheld computing device of claim 1, wherein the detachable visual display unit includes a backlit display.

12. The handheld computing device of claim 1, wherein the detachable visual display unit includes a reflective display.

13. The handheld computing device of claim 1, wherein the detachable visual display unit includes a monochrome display.

14. The handheld computing device of claim 1, wherein the detachable visual display unit includes a color display.

15. A handheld computing device facilitating a detachable visual display unit comprising:
a processing unit;
a power source;
a communication port for communicating with a detachable visual display unit, wherein the communication port is capable of receiving information representative of properties of the detachable visual display unit.

16. Cancelled.

17. The handheld computing device of claim 15, wherein the communication port receives information representative of the detachable visual display unit properties based on at least one identifier pin associated with the detachable visual display unit.

18. The handheld computing device of claim 15, wherein the communication port receives information representative of the detachable visual display unit properties based on an identifier signal transmitted by the detachable visual display unit.

19. The handheld computing device of claim 15, wherein the processing unit includes a plurality of display drivers utilized based on the information representative of the properties of the detachable visual display unit.

20. The handheld computing device of claim 15, wherein the communication port includes a wireless transceiver.

21. The handheld computing device of claim 20, wherein the wireless transceiver communicates using the Bluetooth wireless network protocol.

22. A visual display unit for a handheld computing device, the visual display unit comprising:

a housing detachable from the handheld computing device;

a display screen; and

a communication interface including an identifier indicia to indicate to a handheld computing device the properties of the visual display unit.

23. The visual display unit of claim 22, wherein the visual display unit is foldable to present a larger or smaller display screen.

24. The visual display unit of claim 23, wherein the visual display unit includes an apparatus to anchor the visual display unit to the handheld computing device.

25. The visual display unit of claim 22, wherein the display screen is color.

26. A method of displaying data from a handheld computing device, comprising:
detecting the properties of a detachable visual display unit communicatively coupled to the handheld computing device;

updating display drivers based on the detachable visual display unit properties detected; and

transmitting data from the handheld computing device to the communicatively coupled detachable visual display unit.

27. The method of claim 26, wherein detecting the properties of a detachable visual display unit includes receiving a signal transmitted by the detachable visual display unit.

28. The method of claim 26, further comprising:
bringing the detachable visual display unit into communication with the handheld computer device.

29. The method of claim 28, further comprising:
detaching the detachable visual display unit from the handheld computing device.